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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,280	10/04/2005	Uwe Foll	449122084600	4022
25227 7590 06/27/2008 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
MURRAY, DANIEL C				
ART UNIT		PAPER NUMBER		
2143				
MAIL DATE		DELIVERY MODE		
06/27/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,280

Applicant(s)

FOLL ET AL.

Examiner

DANIEL MURRAY

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04OCT2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/ICE)
Paper No(s)/Mail Date 03/JAN/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Applicant has indicated a claim to foreign priority in the declaration. However, no prior foreign application is listed.

Information Disclosure Statement

2. The information disclosure statement submitted on 03JAN2006 has been considered by the Examiner and made of record in the application.

Specification

3. The disclosure is objected to because of the following informalities:

➤ Page 1 lines 16, Replace “US-A-995 822” before “discloses” with --US 5,995,822--

Appropriate correction is required.

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic

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documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

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- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
 - (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(c).
 - (l) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.
4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

5. **Claim 6** is objected to under 37 CFR 1.75 as being a substantial duplicate of **claim 5**. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-3, 5-6, 8, and 11-12** are rejected under 35 U.S.C. 102(b) as being anticipated by **Hamilton et al. (WO 02/096025 A1)**.

a) Consider **claim 1**, Hamilton et al. clearly show and disclose, a method for monitoring and controlling a number of available decentralized IP budgets of a subscriber in a packet-based communications network during an online assessment of charges for data transmissions (abstract, paragraph [08], [09]), comprising: allocating a plurality of available IP budgets in a data-flow-specific manner to a data flow in a context that can be assigned to the subscriber (abstract, paragraph [09], [10], [11], [72]); providing a higher-order control function in a network node of the communications network, the control function charging the data-flow-specific IP budget according to a resource use of a data flow based on charge assessment specifications issued by a charge-assessing computer during a resource utilization of the data flow in a context that can be assigned to the subscriber (abstract, paragraph [09], [10], [11], [45], [69], [73], [218]); and effecting a partial or complete transmission of the IP budget between selected data flows on a case-by-case basis, whereby the control function effects a reallocation or transfer of the IP budget according to the specifications of the charge-assessing computer (abstract, paragraph [12], [74], [75], [218]).

b) Consider **claim 2**, and **as applied to claim 1 above**, Hamilton et al. clearly show and disclose, the method according to claim 1, wherein when a data flow is added or removed, the charge assessing computer or the control function requests a return of allocated IP budgets

according to the charge assessment specifications of the charge-assessing computer and reallocates the IP budgets (paragraph [230], [231], [232], [233]).

c) Consider **claim 3**, and **as applied to claim 1 above**, Hamilton et al. clearly show and disclose, the method according to claim 1, wherein the charge assessing computer or the control function requests a return of allocated IP budgets at a point in time specified by the charge-assessing computer according to the charge assessment specifications of the charge-assessing computer, and reallocates the IP budgets (paragraph [230], [231], [232], [233]).

d) Consider **claims 5 and 6**, and **as applied to claim 1 above**, Hamilton et al. clearly show and disclose, the method according to claim 1, wherein some or all of the data-flow-specific IP budget of a first data flow is transferred by the control unit to a second data flow if the second data flow belongs to a context that can be allocated to an IP address of a same subscriber (paragraph [102], [106], [107], [213], [215]).

e) Consider **claim 8**, and **as applied to claim 1 above**, Hamilton et al. clearly show and disclose, the method according to claim 1, wherein the charge-assessing computer issues a transfer authorization, within the charge assessment specifications, between a first and a second data flow by marking the first and the second data flow with a common identifier (paragraph [102], [106], [107], [213], [215]).

f) Consider **claim 11**, and **as applied to claim 1 above**, Hamilton et al. clearly show and disclose, the method according to claim 1, wherein a GPRS network is used as the packet-based communications network (paragraph [07], [08], [77], [78]).

g) Consider **claim 12**, and **as applied to claim 11 above**, Hamilton et al. clearly show and disclose, the method according to claim 11, wherein the control function is located in a GGSN (paragraph [07], [08], [77], [78]).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. **Claims 9-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hamilton et al. (WO 02/096025 A1)**.

a) Consider **claim 9**, and as **applied to claim 1 above**, Hamilton et al. clearly show and disclose, the method according to claim 1. However, Hamilton et al. does not specifically disclose a data-flow-specific weighting factor is specified by the charge-assessing computer for charge assessment of a data flow.

Nonetheless, it would have been obvious at the time the invention was made to use data-flow-specific weighting factor is specified by the charge-assessing computer for charge assessment of a data flow. The use of weighting factors to assign a higher/lower weight to a particular item is well known in the art.

b) Consider **claim 10**, and as **applied to claim 9 above**, Hamilton et al. clearly show and disclose, the method according to claim 9. However, Hamilton et al. does not specifically disclose a data-flow-specific weighting factor is specified by the charge-assessing computer for charge assessment of a data flow by means of a table or pointer to a position in a table.

Nonetheless, it would have been obvious at the time the invention was made for the charge assessment of a data flow by means of a table or pointer to a position in a table. The use of tables for the storage of data and the use of pointers to entries in the tables are notoriously well known art. It would have been obvious to store charge assessment data and data-flow-specific weighting factors in a table and access the entries to the table for charge assessment using a pointer.

12. **Claims 4, 7, and 13-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hamilton et al. (WO 02/096025 A1)** in view of **Smith et al. (US Patent # 5,995,822)**.

a) Consider **claim 4**, and as **applied to claim 1 above**, Hamilton et al. clearly show and disclose, the method according to claim 1, wherein some or all of the data-flow-specific IP budget of a first data flow is transferred by the control unit according to the charge assessment specifications

of the charge assessing computer to a second data flow if a data-flow-specific IP budget allocated to the second data flow reaches a threshold value or is completely used up.

Smith et al. show and disclose a method for use by telephone system operators to ensure that pre-paid subscribers can pay for simultaneous telephone calls, wherein some or all of the data-flow-specific IP budget of a first data flow is transferred by the control unit according to the charge assessment specifications of the charge assessing computer to a second data flow if a data-flow-specific IP budget allocated to the second data flow reaches a threshold value or is completely used up (figure 2A, figure 2B, figure 3, abstract, column 3 lines 52-67, column 4 lines 1-8).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Smith et al. into the system of Hamilton et al. for the purpose of monitoring and controlling data services and charge assessment for data services.

b) Consider **claim 7**, and **as applied to claim 1 above**, Hamilton et al. clearly show and disclose, the method according to claim 1. However, Hamilton et al. does not specifically disclose some or all of the data-flow-specific IP budget of a first data flow is transferred by the control unit to a second data flow if the second data flow belongs to the same context as the first data flow.

Smith et al. show and disclose a method for use by telephone system operators to ensure that pre-paid subscribers can pay for simultaneous telephone calls, wherein some or all of the data-flow-specific IP budget of a first data flow is transferred by the control unit to a second data flow if the second data flow belongs to the same context as the first data flow (figure 2A, figure 2B, figure 3, abstract, column 3 lines 52-67, column 4 lines 1-8).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Smith et al. into the system of Hamilton et al. for the purpose of monitoring and controlling data services and charge assessment for data services.

c) Consider **claim 13**, and **as applied to claim 1 above**, Hamilton et al. clearly show and disclose, the method according to claim 1, wherein the control function requests a return of the IP budgets of all other data flows when a threshold value of a data-flow-specific IP budget of any data flow is reached, and transfers them to the charge assessing computer.

Smith et al. show and disclose a method for use by telephone system operators to ensure that pre-paid subscribers can pay for simultaneous telephone calls, wherein the control function requests a return of the IP budgets of all other data flows when a threshold value of a data-flow-specific IP budget of any data flow is reached, and transfers them to the charge assessing computer (figure 2A, figure 2B, figure 3, abstract, column 3 lines 52-67, column 4 lines 1-8).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Smith et al. into the system of Hamilton et al. for the purpose of monitoring and controlling data services and charge assessment for data services.

d) Consider **claim 14**, and **as applied to claim 1 above**, Hamilton et al. clearly show and disclose, the method according to claim 1, wherein part of a data-flow-specific IP budget of a data flow terminated by the subscriber is transferred by the control function to one or more existing or new data flows.

Smith et al. show and disclose a method for use by telephone system operators to ensure that pre-paid subscribers can pay for simultaneous telephone calls, wherein part of a data-flow-specific IP budget of a data flow terminated by the subscriber is transferred by the control function to one or more existing or new data flows (figure 2A, figure 2B, figure 3, abstract, column 3 lines 52-67, column 4 lines 1-8).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Smith et al. into the system of Hamilton et al. for the purpose of monitoring and controlling data services and charge assessment for data services.

e) Consider **claim 15**, and **as applied to claim 1 above**, Hamilton et al. clearly show and disclose, the method according to claim 1, wherein when a new data flow is added by the control function according to the charge assessment specifications of the charge-assessing computer, at least part of the IP budget of at least one existing data flow is transferred to the new data flow.

Smith et al. show and disclose a method for use by telephone system operators to ensure that pre-paid subscribers can pay for simultaneous telephone calls, wherein when a new data flow is added by the control function according to the charge assessment specifications of the charge-assessing computer, at least part of the IP budget of at least one existing data flow is transferred to the new data flow (figure 2A, figure 2B, figure 3, abstract, column 3 lines 52-67, column 4 lines 1-8).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Smith et al. into the system of Hamilton et al. for the purpose of monitoring and controlling data services and charge assessment for data services.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- | | |
|-------------------|-------------------|
| ➤ US 6,456,986 B1 | ➤ US 6,480,485 B1 |
| ➤ 5,784,443 | ➤ 5,815,560 |
| ➤ 5,812,533 | ➤ 5,742,905 |
| ➤ 6,047,271 | ➤ 5,852,812 |
| ➤ US 6,199,047 B1 | ➤ US 6,704,563 B1 |
| ➤ US 7,305,073 B2 | ➤ 5,923,741 |
| ➤ 5,790,643 | |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL MURRAY whose telephone number is 571-270-1773. The examiner can normally be reached on Monday - Friday 0800-1700 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571)-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel Murray/
Examiner, Art Unit 2143

/Nathan J. Flynn/
Supervisory Patent Examiner, Art Unit 2154

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